

for
DAC

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 8 - 1995

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTIAAN J. SNIJDERS,
ALPHONSUS M.L.D. HOENDEROS,
WILLEM G. L. DE JONG and
ADRIANUS P. DE JONG

Appeal No. 96-0378
Application 08/039,353¹

ON BRIEF

Before MEISTER and ABRAMS, *Administrative Patent Judges*, and
CRAWFORD, *Acting Administrative Patent Judge*.

MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 8-15 and 18.² Claims 16 and 17, the only other claims present in the application, have been indicated as being allowable subject to

¹ Application for patent filed April 22, 1993. According to applicants, the Application is a 371 of /NL91/00212 filed October 24, 1991.

² Claim 10 has been amended subsequent to final rejection.

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the requirement that they be rewritten to include all the subject matter of the claims from which they depend. We affirm-in-part.

The appellants' invention pertains to a sanitary seat assembly which facilitates the washing of the lower parts of the body of a user. Independent claim 8 is further illustrative of the appealed subject matter and a copy thereof, as it appears in the appendix to the appellants' brief, is appended to this opinion.

The references of record relied on by the Examiner are:

Olsen	467,017	Jan. 12, 1892
Ford	963,538	July 5, 1910

Claims 8-11, 13-15 and 18 stand rejected under 35 U.S.C.

102(b) as being anticipated by Olsen. According to the examiner

[t]he first seat part is the surface of the bed, the second seat part is element 77 and the movement means is seen in Fig. 4. The upper seating surface of 77 is positionable above the bed surface as seen in Fig. 2 and below as seen in Fig. 4. Re: claim 10, during the movement defined supra the claim 10 position will be attained. Re: claim 13, element 31 teaches the back rest. Re: claim 14, element 32 meets this claim in that one's arm could be rested thereon. Re : claim 15, the handle is shown at 43. Claim 18 is met by the static position of Fig. 2. (see answer, pages 2 and 3)

Claim 12 stands rejected under 35 U.S.C. 103 as being unpatentable over Olsen in view of Ford. The examiner is of the opinion that it would have been obvious to provide the commode of Olsen with a flushing hose in view of the teachings of Ford.

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Rather than reiterate the arguments of the appellants and the examiner in support of their respective position, reference is made to the brief and answer for the full exposition thereof.

OPINION

We have carefully reviewed the appellants' invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellants in the brief and by the examiner in the answer. As a consequence of this review, we will sustain the rejections of claims 8-11, 13 and 15 under 35 U.S.C. 102(b) and claim 12 under 35 U.S.C. 103. We will not, however, sustain the examiner's rejection of claims 14 and 18 under 35 U.S.C. 102(b). Our reasons for these determinations follow.

Considering first the rejection of claims 8-11, 13 and 15 under 35 U.S.C. 102(b) as being anticipated by Olsen, the appellants initially urge that "any art rejection even under 35 U.S.C. 102(b), anticipation, must relate to the problem presented" (see brief, page 4) and thereafter contends, with respect to Olsen, that there is

no disclosure of washing activities permitted in connection with the use of such bed in the invalid configuration. The thrust of the disclosure is a bed which can be either used in an invalid configuration (with a commode) or as an ordinary bed. Additionally, there is no disclosure as to whether a mattress is disposed on the bed in an invalid configuration or whether the individual lies on the spring, nevertheless, it is respectfully submitted that there is no disclosure that

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the invalid bed can be a seat, and there is a difference between a bed and a seat!

Clearly defined in Webster's Dictionary, a seat is ..."
1. Posture or way of sitting as on a horseback. 2. a.
The place at, or the thing on which one sits. b. ---
5. A chair, stool, bench, pew, etc. or a part of it on
which one sits...". ... It is respectfully submitted
that a bed is not a seat, and that 35 U.S.C. § 102(b)
does not permit of such extrapolation. (see brief,
pages 5 and 6)

We are unpersuaded by the appellants' arguments. The terminology in a pending application's claims is to be given its broadest reasonable interpretation (see *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (see *Sjolund v. Musland*, 847 F.2d 1573, 6 USPQ2d 2020 (Fed. Cir. 1988)). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See *Verdegaal Brothers Inc. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). A prior art reference anticipates the subject matter of a claim when that reference discloses, either expressly or under the principles of inherency, each and every element set forth in the claim (see *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990)); however, the law of anticipation does not require that the reference teach what the appellants are claim-

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ing, but only that the claims on appeal "read on" something disclosed in the reference (*see Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)).

The appellants initially focus on the fact that Olsen does not disclose any "washing activities." We must point out, however, that the only disclosure of "washing activities" appearing in independent claim 8 is in the preamble wherein it is set forth that the seat assembly is for providing a sitting place for a human body "to facilitate washing of lower parts." It is well settled that a preamble generally does not limit the scope of a claim if it merely states the invention's purpose or intended use. *See In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994)). While no litmus test can be given with respect to when the introductory words of a claim constitute a statement of purpose for a device or are, in themselves, additional structural limitations of a claim (*see Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989)), in a case such as this where the bed or seat of Olsen has the **capability** of "facilitating washing," we are of the opinion that the recitation of "to facilitate washing of lower parts" appearing in the preamble of claim 8 is merely a statement of intended purpose or use which may not be relied on to distinguish structure from the prior art. *See In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974), *In re Yanush*, 477 F.2d 958, 177 USPQ

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705 (CCPA 1973), *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *Loctite Corp. v. Ultraseal, Ltd.*, 781 F.2d 861, 228 USPQ 90, (Fed. Cir. 1985). Note also *LaBounty Manufacturing v. International Trade Commission*, 958 F.2d 1066, 22 USPQ2d 1025 (Fed. Cir. 1992). In this regard, we also observe that bed-ridden patients in hospitals or nursing homes are often washed in "bed" and the second seat part or commode 77 of Olsen clearly has the capability of holding water.

The appellants also make much of the fact that the device of Olsen is described as being a bed rather than a seat and have cited dictionary definitions of a "seat" and a "bed." In particular, the appellants have cited a definition of a seat as being the "place at, or the thing on which one sits." From our perspective, the "bed" of Olsen falls within that definition. As the examiner has correctly noted, the springs 23 of Olsen provide a surface upon which a person can sit while the member 31 provides a backrest. The appellants also note that the bed of Olsen is intended to be used with a mattress. While this may be true, Olsen neither discloses a mattress nor has the examiner relied upon a mattress. The examiner's position is simply that the springs 23 of Olsen form a surface upon which a person may "sit" and, accordingly, Olsen's device may be considered to be a "seat" as broadly claimed. As our reviewing court set forth in *LaBounty Manufacturing* at 958 F.2d 1075, 22 USPQ2d 1032 (in

quoting with approval from *Dwight & Lloyd Sintering Co. v. Greenawalt*, 27 F.2d 823, 828 (2d Cir. 1928)):

The use for which the [anticipatory] apparatus was intended is irrelevant, if it could be employed without change for the purposes of the patent; the statute authorizes the patenting of machines, not of their uses. So far as we can see, the disclosed apparatus could be used for "sintering" without any change whatever, except to reverse the fans, a matter of operation.

This principle applies here inasmuch as a person could sit on the device of Olsen (i.e., springs 23) without any change in structure whatsoever.

With respect to claim 9, the appellants argue that the second seat part or commode 77 of Olsen "is not moved up and down in use." This is totally incorrect (see Olsen, page 3, lines 27-31; compare also Figs. 3 and 4).

As to claim 10, the appellants contend that Olsen does not teach the claimed "same height" position. We do not agree. Initially we note that claim 10 specifies that the parts "**are positionable** in essentially the same height" (emphasis ours) and thus merely sets forth what the claimed structure is **capable of doing**. Accordingly, the reference to Olsen need not actually be used for the stated purpose in order to meet claim 10, but must only be capable of such use and not possess any characteristic which would prevent such use. *See In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). Moreover, the broad recitation of

"positionable" does not require that second seat part be fixed at the "same height" during use. As the examiner has correctly noted, when the second seat part or commode 77 of Olsen is moved from the Fig. 3 to Fig. 4 positions (note page 3, lines 27-31), the level of his seat parts 23, 77 must inherently be at the "same height" at some point during this movement.

With respect to claim 11 we are at a loss to understand the appellants' contention that the commode or second seat part 77 of Olsen is not "suitable for holding water." The member 77 of Olsen is obviously designed to hold urine and, accordingly, we are of the opinion that the examiner had a reasonable basis for concluding that this member would also hold water. In a case such as this where the critical function for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art device, it is incumbent upon appellants to prove that the prior art device does not in fact possess the characteristics relied on. See *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); *In re Glass*, 474 F.2d 1015, 176 USPQ 529 (CCPA 1973); *In re Ludtke*, 441 F.2d 660, 169 USPQ 563 (CCPA 1971) and *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). Here, the appellants have not satisfied this burden.

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As to claim 13 the appellants appear to concede that the element 31 of Olsen "could be construed as a back rest" but nevertheless argue

it is unequivocally clear that the cooperating seat parts as alleged by the Examiner would not be cooperating with a human lying on such mattress if a back is resting on the element 31 including pillows concomitant with a buttock on the seat parts (unless a person was of unusual configuration). (see brief, page 9)

This argument, however, is not commensurate with the scope of the claim since there is no claimed requirement that users have their buttocks on the seat parts while at the same time resting their back on the back rest. It is well settled that features not claimed may not be relied upon in support of patentability. *See In re Self*, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982). Moreover, even if there were such a claimed limitation, we are of the opinion that the device of Olsen would have the **capability** of being used in such a manner.

With respect to claim 15 the appellants argue that "the handle 47 of the Olsen reference cannot be used by the user concomitantly rested on the seat parts...." Once again, this argument is not commensurate with the scope of the claimed subject matter. There is absolutely nothing in claim 15 which requires the handle to be used "by the user concomitantly rested on the seat parts." Moreover, even if there were, there is no evidence of record to support the appellants' contention that the

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handle of Olsen "cannot be used by the user" Counsel's arguments in the brief cannot take the place of evidence. *See In re DeBlauwe*, 736 F.2d 699, 222 USPQ 191 (Fed. Cir. 1984) and *In re Pearson* 494 F.2d 1399, 181 USPQ 641 (CCPA 1974).

In view of the foregoing, we will sustain the examiner's rejection of claims 8-11, 13 and 15 under 35 U.S.C. 102(b).

We consider next the examiner's rejection of claims 14 and 18 under 35 U.S.C. 102(b) as being anticipated by Olsen. With respect to claim 14 the examiner has taken the position that the element 32 of Olsen can be considered to correspond to the claimed armrests. The elements 32 of Olsen, however, are "spring bands" which form the supporting surface of backrest and therefore are a **necessary part of the backrest**. On the other hand, claim 14 requires "armrests mounted to said backrest," thus clearly indicating that the armrests are something in **addition** to the backrest. This being the case, we are not of the opinion that the spring bands 32 of Olsen can fairly be construed to be "armrests" as defined by claim 14. As to claim 18 the examiner has taken that the claimed "locking means" is "met by the static position of Fig. 2." While it is true that the claims in a patent application are to be given their broadest reasonable interpretation **consistent with the specification** (*see In re Zletz, supra*), and limitations from a pending application's specification will not be read into the claims (*see Sjolund v.*

Musland, supra), it is also well settled that terms in a claim should be construed as those skilled in the art would construe them (see *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988) and *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977)). Apparently the examiner believes that the frictional forces inherently present in the various gears and linkages of Olsen can be considered to correspond to the claimed locking means. Such a position, in our view, expands the meaning to be given to the claimed locking means beyond all reason. We can think of no circumstances under which the artisan, consistent with the appellants' specification, would construe such frictional forces to correspond to the claimed locking means. This being the case, we will not sustain the examiner's rejection of claims 14 and 18 under 35 U.S.C. 102(b).

Considering last the rejection of claim 12 under 35 U.S.C. 103 as being unpatentable over Olsen in view of Ford, the brief states that

[t]he problem confronting the Olsen reference was convertibility of a bed configuration from one of standard usage to one for use by an invalid person, and in particular, the capability of providing a commode in a central position therein. The Ford reference relates to the static positioning of a commode having a source of waters for apparently washing the buttock of the person in the bed. It is clear that the assembly of the Ford reference is not capable of moving up or down and to substitute the commode configuration of Ford and that of Olsen might not be unreasonable, it is still totally out of context and the difference between a

seat assembly having seat parts and a bed, and the normal use of a bed therein. (see page 12)

The examiner, however has not proposed to bodily substitute the commode of Ford for the commode of Olsen as the appellants argue. Instead, the examiner has taken the position that it would be obvious to provide the commode of Olsen with a **flushing hose** in view of the teachings of Ford and we find ourselves in agreement with this position. In this regard, we observe that all of the features of the secondary reference need not be bodily incorporated into the primary reference (*see In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981)) and the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment (*see Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 USPQ 1025 (Fed. Cir. 1984)). We also observe that in order to establish a *prima facie* case of obviousness, the purpose proposed as the reason why the artisan would have found the claimed subject matter to have been obvious need not be identical to the purpose or problem which the appellants indicate to be the basis for having made the invention. *See In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992) and *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990). In addition, it is not required that the prior art teachings relied upon disclose the same advantage that the appellants allege; all that is required is

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that there is a reasonable suggestion to do what the claimed subject matter encompasses. See *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976); *In re Wilder*, 429 F.2d 447, 166 USPQ 545 (CCPA 1970) and *Ex parte Obiaya*, 227 USPQ 58 (BPAI 1985), *aff'd mem.*, 795 F.2d 1017 (Fed. Cir. 1986).

In view of the above, we will sustain the examiner's rejection of claim 12 under 35 U.S.C. 103.

In summary:

The examiner's rejections of claims 8-11, 13 and 15 under 35 U.S.C. 102(b) and claim 12 under 35 U.S.C. 103 are sustained.

The examiner's rejection of claims 14 and 18 under 35 U.S.C. 102(b) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

AFFIRMED-IN-PART

JAMES M. MEISTER
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

MURRIEL E. CRAWFORD
Acting Administrative Patent Judge

BOARD OF PATENT
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APPENDIX

8. A sanitary seat assembly for providing a sitting place for a human body to facilitate washing of lower parts, which comprises:

a first seat part;

a second seat part cooperating with said first seat part;

movement means for moving in a vertical direction, one of said seat parts from a first position to a second position, said second seat part being positioned above first seat part in said first position and below said first seat part and said second position.